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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,292	09/10/2003	Yojiro Tagawa	03560.003355.	2453
5514 7590 02/05/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER LAM, HUNG H	
			ART UNIT 2622	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/658,292	<b>Applicant(s)</b> TAGAWA, YOJIRO	
	<b>Examiner</b> Hung H. Lam	<b>Art Unit</b> 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 2,5,6,9,13,17 and 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-4,7-8,10-12,14-16 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Election/Restrictions*

2. Claims 2, 5, 6, 9, 13, 17 and 19-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 08/28/06.

### *Specification*

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Claim Rejections - 35 USC § 101*

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

5. Claims 15-16 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 15-16 and 18 define a program embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed a program can range from paper on which the program is written, to a program simply contemplated and memorized by a person.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 3-4, 7-8, 10-12, 14-16 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Davis (US-7,010,144).

Regarding **claim 1**, Davis discloses an image processing apparatus comprising recording means for storing an image file including an image area for storing image data and also including an attribute area for storing attribute information (Figs. 1 and 3; see memory 20 and DWM Image/Meta data; Col. 9, Ln. 57-Col. 10, Ln. 12);

description means for describing the attribute information using a tag defined by a tag-definable markup language (Fig. 3; see Meta Data block; Col. 2, Ln. 60-Col. 3, Ln. 21; Col. 14, Ln. 53-Col. 15, Ln. 25; Davis further teaches that metadata may be specified using XML or other standard format); and

writing means for writing the attribute information described by the description means into an arbitrary attribute area (Figs. 1 and 3-4; a writing means is inherently included in order for image and metadata to be written into a memory or server).

Regarding **claim 3**, Davis discloses an image processing apparatus comprising recording means for storing an image file including an image area for storing image data and also including an attribute area for storing attribute information (Figs. 1 and 3; see memory 20 and DWM Image/Meta data; Col. 9, Ln. 57-Col. 10, Ln. 12);

description means for describing the attribute information using a tag defined by a tag-definable markup language (Fig. 3; see Meta Data block; Col. 2, Ln. 60-Col. 3, Ln. 21; Col. 14, Ln. 53-Col. 15, Ln. 25; Davis further teaches that metadata may be specified using XML or other standard format);

encryption means for encrypting part or all of the attribute information described by the description means (Col. 10, Ln. 11-Col. 11, Ln. 25; Col. 15, Ln. 10-25); and

writing means for writing the attribute information encrypted by the encryption means into an arbitrary attribute area (Figs. 1 and 3-4; a writing means is inherently included in order for image and metadata to be written into a memory or server).

Regarding **claim 4**, Davis discloses an image processing apparatus according to claim 3, further comprising separation means for separating image data and attribute information included in the stored image file (Col. 12, Ln. 8-Col. 13, Ln. 20);

decryption means for decrypting the encrypted part of the attribute information separated by the separation means (Col. 12, Ln. 37-59); and

extraction means for extracting original attribute information by analyzing the attribute information described using the defined tag and decrypted by the decryption means (Col. 12, Ln. 8-Col. 13, Ln. 20).

Regarding **claim 7**, Davis discloses an image processing apparatus comprising recording means for storing an image file including an image area for storing image data and also including an attribute area for storing attribute information (Figs. 1 and 3; see memory 20 and DWM Image/Meta data; Col. 9, Ln. 57-Col. 10, Ln. 12);

description means for describing the attribute information using a tag defined by a tag-definable markup language (Fig. 3; see Meta Data block; Col. 2, Ln. 60-Col. 3, Ln. 21; Col. 14, Ln. 53-Col. 15, Ln. 25; Davis further teaches that metadata may be specified using XML or other standard format);

encryption-and-compression means for encrypting and compressing part or all of the attribute information described by the description means (Col. 10, Ln. 11-Col. 11, Ln. 25; Col. 15, Ln. 10-25); and

writing means for writing the attribute information encrypted and compressed by the encryption-and-compression means into an arbitrary attribute area (Col. 10, Ln. 11-Col. 11, Ln. 25; Col. 15, Ln. 10-25; Figs. 1 and 3-4; a writing means is inherently included in order for image and metadata to be written into a memory or server).

Regarding **claim 8**, Davis discloses an image processing apparatus according to claim 7, further comprising separation means for separating image data and attribute information included in the stored image file (Col. 12, Ln. 8-Col. 13, Ln. 20);

decompression-and-decryption means for decompressing and decrypting the encrypted and compressed part of the attribute information separated by the separation means (Col. 11, Ln. 15-20; Col. 12, Ln. 37-59); and

extraction means for extracting original attribute information by analyzing the attribute information described using the defined tag and decompressed and decrypted by the decompression-and-decryption means (Col. 12, Ln. 8-Col. 13, Ln. 20).

Regarding **claim 10**, Davis discloses an image processing apparatus according to claim 1, further comprising display means (Fig. 1; screen 36) for displaying the image and the attribute information output by the output means (Col. 6, Ln. 4-18).

Regarding **claim 11**, Davis discloses an image processing method comprising the steps of

storing an image file including an image area for storing image data and also including an attribute area for storing attribute information (Figs. 1 and 3; see memory 20 and DWM Image/Meta data; Col. 9, Ln. 57-Col. 10, Ln. 12);

describing the attribute information using a tag defined by a tag-definable markup language (Fig. 3; see Meta Data block; Col. 2, Ln. 60-Col. 3, Ln. 21; Col. 14, Ln. 53-Col. 15, Ln. 25: Davis further teaches that metadata may be specified using XML or other standard format); and

writing the attribute information described in the description step into an arbitrary attribute area (Figs. 1 and 3-4; a writing means is inherently included in order for image and metadata to be written into a memory or server).



Regarding **claim 12**, Davis discloses an image processing method comprising the steps of

storing an image file including an image area for storing image data and also including an attribute area for storing attribute information (Figs. 1 and 3; see memory 20 and DWM Image/Meta data; Col. 9, Ln. 57-Col. 10, Ln. 12);

describing the attribute information using a tag defined by a tag-definable markup language (Fig. 3; see Meta Data block; Col. 2, Ln. 60-Col. 3, Ln. 21; Col. 14, Ln. 53-Col. 15, Ln. 25; Davis further teaches that metadata may be specified using XML or other standard format);

encrypting part or all of the attribute information described in the description step; and writing the attribute information encrypted in the encryption step into an arbitrary attribute area (Col. 10, Ln. 11-Col. 11, Ln. 25; Col. 15, Ln. 10-25).

Regarding **claim 14**, Davis discloses an image processing method comprising the steps of

storing an image file including an image area for storing image data and also including an attribute area for storing attribute information (Figs. 1 and 3; see memory 20 and DWM Image/Meta data; Col. 9, Ln. 57-Col. 10, Ln. 12);

describing the attribute information using a tag defined by a tag-definable markup language (Fig. 3; see Meta Data block; Col. 2, Ln. 60-Col. 3, Ln. 21; Col. 14, Ln. 53-

Col. 15, Ln. 25: Davis further teaches that metadata may be specified using XML or other standard format);

encrypting and compressing part or all of the attribute information described in the description step (Col. 10, Ln. 11-Col. 11, Ln. 25; Col. 15, Ln. 10-25); and

writing the attribute information encrypted and compressed in the encryption-and-compression step into an arbitrary attribute area (Col. 10, Ln. 11-Col. 11, Ln. 25; Col. 15, Ln. 10-25; Figs. 1 and 3-4; a writing means is inherently included in order for image and metadata to be written into a memory or server).

Regarding **claim 15**, Davis discloses a program for causing a computer to execute a procedure comprising the steps of

storing an image file including an image area for storing image data and also including an attribute area for storing attribute information (Figs. 1 and 3; see memory 20 and DWM Image/Meta data; Col. 9, Ln. 57-Col. 10, Ln. 12);

describing the attribute information using a tag defined by a tag-definable markup language (Fig. 3; see Meta Data block; Col. 2, Ln. 60-Col. 3, Ln. 21; Col. 14, Ln. 53-Col. 15, Ln. 25: Davis further teaches that metadata may be specified using XML or other standard format); and

writing the attribute information described in the description step into an arbitrary attribute area (Figs. 1 and 3-4; a writing means is inherently included in order for image and metadata to be written into a memory or server).

Regarding **claim 16**, Davis discloses a program for causing a computer to execute a procedure comprising the steps of

storing an image file including an image area for storing image data and also including an attribute area for storing attribute information (Figs. 1 and 3; see memory 20 and DWM Image/Meta data; Col. 9, Ln. 57-Col. 10, Ln. 12);

describing the attribute information using a tag defined by a tag-definable markup language (Fig. 3; see Meta Data block; Col. 2, Ln. 60-Col. 3, Ln. 21; Col. 14, Ln. 53-Col. 15, Ln. 25; Davis further teaches that metadata may be specified using XML or other standard format);

encrypting part or all of the attribute information described in the description step (Col. 10, Ln. 11-Col. 11, Ln. 25; Col. 15, Ln. 10-25); and

writing the attribute information encrypted in the encryption step into an arbitrary attribute area (Col. 10, Ln. 11-Col. 11, Ln. 25; Col. 15, Ln. 10-25; Figs. 1 and 3-4; a writing means is inherently included in order for image and metadata to be written into a memory or server).

Regarding **claim 18**, Davis discloses a program for causing a computer to execute a procedure comprising the steps of

storing an image file including an image area for storing image data and also including an attribute area for storing attribute information (Figs. 1 and 3; see memory 20 and DWM Image/Meta data; Col. 9, Ln. 57-Col. 10, Ln. 12);

describing the attribute information using a tag defined by a tag-definable markup language (Fig. 3; see Meta Data block; Col. 2, Ln. 60-Col. 3, Ln. 21; Col. 14, Ln. 53-Col. 15, Ln. 25: Davis further teaches that metadata may be specified using XML or other standard format);

encrypting and compressing part or all of the attribute information described in the description step (Col. 10, Ln. 11-Col. 11, Ln. 25; Col. 15, Ln. 10-25); and

writing the attribute information encrypted and compressed in the encryption-and-compression step into an arbitrary attribute area (Col. 10, Ln. 11-Col. 11, Ln. 25; Col. 15, Ln. 10-25; Figs. 1 and 3-4; a writing means is inherently included in order for image and metadata to be written into a memory or server).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Hoisko (US-2002/0,113,757) discloses a camera wherein information based on HTML, XML, RDF or JPEG 2000 may alternatively be embedded within the image structure or within the image binary.

b) Cohen (US-6,947,954) discloses an image server system wherein each file comprises a header, metadata and image data;

c) McIntyre (US-2003/0,154,178) discloses an apparatus for associating non image data with a digital image of a user.

d) Gropper (US-2003/0,005,464) discloses a file system that archive images encoded in JPEG 2000 format and meta-data file encoded in XML format.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung H. Lam whose telephone number is 571-272-7367. The examiner can normally be reached on Monday - Friday 8AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LIN YE can be reached on 571-272-7372. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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HL  
02/03/08

A handwritten signature in black ink, appearing to be "J. J. Heller" or similar, with a stylized flourish at the end.